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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,557	12/22/2000	Bob Haschart	962.01 IUS2	1682
7590 06/09/2008 SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. Box 2938 Minneapolis, MN 55402			EXAMINER ENGELSKIRCHEN, JEREMY D	
			ART UNIT 2169	PAPER NUMBER
			MAIL DATE 06/09/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/746,557

**Applicant(s)**

HASCHART ET AL.

**Examiner**

JEREMY D. ENGELSKIRCHEN

**Art Unit**

2169

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 126-147 and 158-179 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 126-134, 136-147 and 158-179 is/are rejected.
- 7) ☒ Claim(s) 135 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/10/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 126-147 and 158-179 are pending in this application. Claims 126, 137, 143, 147, 158, 162, and 167 have been amended. Claims 177-179 are newly added claims.

### *Response to Amendment*

2. This Office Action is in response to applicant's communications filed January 18, 2008 in response to PTO Office Action mailed February 27, 2007. The Applicant's remarks and amendments to the claims were considered with the results that follow.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 126, 137, and 147 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

5. With respect to claim 126, line 7, recites "first user-selectable means for indicating before selection." However, "before selection" lacks clarity and one of ordinary skill cannot determine the scope of the claim due to not being able to understand what is being indicated "before selection".

6. With respect to claim 137, line 4, a "first user-selection means for indicating without user selection whether the first legal document includes at least one portion having compromised legal authority" lacks clarity because it is unclear what the applicant means by a "user-selection

means for indicating *without user selection*". Furthermore, it is unclear that a user-selection means for indicating would not require user selection.

7. With respect to claim 147, line 4, "without user action" lacks clarity because it is unclear what the applicant means by "without user action". "Facilitating human interaction" is in the preamble of the claim; therefore user action to display a legal document is required. User action is required to initiate the displaying of the first legal document and then the negation of user action for indicating how other legal documents have treated legal reasoning, after user action was initially required to display a legal document, renders the claim indefinite.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. **Claims 126-134, 136-147, 167-172, 175, and 177-178 are rejected under 35 U.S.C.**

**102(a) as being anticipated by "Computer Assisted Legal Research *UnPlugged: The User-Friendly Guide to LEXIS-NEXIS and WESTLAW*" by Adam J. Piacente, (copyright 1995-1997), hereafter referred to as Piacente.**

10. Claim 126: Reference is made to pages 330-339 of Piacente. The Lexis-Nexis system is a database which includes legal documents.

Pages 329-330 are first data windows displaying portions of a legal document (a court decision, *Wagner v. Kepler*) which contains citation to other legal documents (other court

decisions, such as *Lasko v. Meier* in top left corner of page 330).

A first control interface (two rows of radio buttons at the top of the screen) exists adjacent the data window. A first control interface (two rows of radio buttons at the top of the screen) exists adjacent the data window. A first user selectable means, for indicating without user selection, (the "Shep" radio button and Shepard's pop-up box at page 331) will activate indications of legal authority on a second interface screen after selection as shown on page 334.

11. Claim 127: Computer interfaces are inherently driven by coded segments on computer readable media.

12. Claim 128: The second interface screen is shown on page 334. The second data window is the lower half of the screen below the dashed line. This data window displays citations to other legal documents (court cases) that reference (see "85 citing references" on page 332) the first legal document (the court case on page 329, *Wagner v. Kepler*).

The second control interface is the upper half of the window above the dashed line. The links <=1> and <=2> are second user selectable means that control both the number and type of references by restricting the resulting references or showing only negative references. A third user selectable means <=4> invokes a help screen, which is a third interface screen.

13. Claim 129: See remarks for claim 127.

14. Claim 130: The second control interface (page 334, upper half of window) provides a visual indication of the number of citations in the second data window ("85 citing references").
15. Claim 131: The list of cases in the second data window on page 334 are documents (cases) for other judicial decisions relating to the same case (the court case on page 329, *Wagner v. Kepler*).
16. Claim 132: The cases listed in the second data window on page 334 include treatment labels "same case" or "dissenting opinion".
17. Claim 133: The cases listed in the second data window on page 334 include quotation indicators, such as "p.61" and "Headnote: 1" indicating where the first case (the court case on page 329, *Wagner v. Kepler*) is quoted.
18. Claim 134: The label "same case" on the first citation on page 334 provides a depth of treatment indicating the significance of the citation to the first legal document (*Wagner v. Kepler*). This indicates that the citation and first legal document are one and the same.
19. Claim 136: See remarks for claim 127.
20. Claim 137: The data window displaying first legal document is the data window on page 329. The first user selection means for indicating without user selection are the "Shep" radio

button (pages 329-330) and Shepard's pop-up window (page 331) to display citation to other legal documents that reference the first document (page 334, lower half of window). Second user selection means  $\leq 1$  and  $\leq 2$  in the upper half of the interface on page 334 are user selections that affect the number and type of citations.

21. Claim 138: See remarks for claim 130.
22. Claim 139: See remarks for claim 132 (a treatment label is also a treatment indicator).
23. Claim 140: See remarks for claim 133.
24. Claim 141: See remarks for claim 134.
25. Claim 142: See remarks for claim 127.
  
26. Claim 143: Lexis-Nexis is a database of legal documents. Page 332 illustrates a data window (above the dashed line on page 332) displaying portions of a legal document (*Wagner v. Kepler*). The case *Wagner v. Kepler* cites other legal documents (other court cases, as seen on page 330). At least one indicator for indicating how other legal documents have treated legal reasoning contained within the first legal document, wherein the one indicator is configured to display concurrently with the one or more portions of the first legal document (see pg. 332; the indicators are displayed concurrently with *Wagner v. Kepler*).
  
27. Claim 144: The indicators (below the dashed line on page 332) are adjacent the data window (above the dashed line on page 332).

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28. Claim 145: Each indicator inherently exists in a color. A first indicator <=1> inherently exists in a first color and a second indicator <=2> inherently exists in a second color. The two colors can be the same, as the claim makes no requirement that the two colors be actually different from each other.

29. Claim 146: The indicators are user selectable and invoke the creation of new screens, such as the screen shown on page 334, which cite other legal documents referencing the first legal document (the *Wagner v. Kepler* case).

30. Claim 147: See remarks for claim 143.

31. Claim 167: Lexis-Nexis is an on-line access system. Pages 329-330 illustrate access to a first legal opinion (*Wagner v. Kepler*). Page 334 is a user interface providing graphical interface features in the form of user selectable icons having an associated display color for indicating by its appearance a status of the first legal opinion as legal precedent, such as the radio button "Shep". All of the icons inherently exist in a certain color. The "Shep" button provides user selectable icons that indicate the status of a legal opinion by their appearance, as found on the Shepard's Signal figure on pg. 30 of "Learning Lexis.com" (Lexus Publishing, Dayton OH (2000), pgs. 1-32, disclosed in applicant's IDS dated 8/30/2004). The five indicators all include different appearances indicating the different statuses of a case.



32. Claim 168: The user selectable icon "Shep" is adjacent to the citation of opinion on page 329.

33. Claim 169: The user selectable icon "Shep" on page 329 is adjacent to a window displaying text of the first legal opinion.

34. Claim 170: Activating the "Shep" radio button produces user selections leading to interface of page 334. Here, the first legal opinion (*Wagner v. Kepler*) is precedent for the other cited legal opinions which follow.

35. Claim 171: Page 334 provides a list of second legal opinions that reference the first legal opinion.

36. Claim 172: See remarks for claim 134.

37. Claim 175: On-line access to cases are provided in response to search queries (instructions page 329).

38. Claim 177: A graphical user interface for use with a database of legal documents (see pg 329), the interface comprising: a region defined to display at least a portion of a first citation to a first legal opinion (see pg. 329, *Wagner v. Kepler*). Page 334 is a user interface providing graphical interface features in the form of user selectable icons having an associated display

color for indicating by its appearance a status of the first legal opinion as legal precedent, such as the radio button "Shep". All of the icons inherently exist in a certain color. The "Shep" button provides user selectable icons that indicate the status of a legal opinion by their appearance, as found on the Shepard's Signal figure on pg. 30 of "Learning Lexis.com" (Lexus Publishing, Dayton OH (2000), pgs. 1-32, disclosed in applicant's IDS dated 8/30/2004). The five indicators all include different appearances indicating the different statuses of a case, responsive to a user selection by displaying further information related to the first legal opinion.

39. Claim 178: See remarks for claim 177; (The five indicators all include different appearances indicating the different statuses of a case).

40. **Claims 158-166, 173-174, 176 and 179 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piacente in view of Official Notice.**

41. Claim 158: On page 332, the upper portion of the interface above the dashed line is a region which displays a first citation (*Wagner v. Kepler*). Indicators are provided below the dashed line (<=1>, <=2>, <=3>, etc.) to respond to user selection (see the "Note" on page 333) to display related cases. The indicators inherently exist in a certain color. The indicators are hyperlinks which are displayed concurrently with the portion of the first legal opinion and they indicate by appearing an authoritative status of the opinion. In response to clicking the hyperlinks, i.e. user selection, additional information is displayed (see note on pg 333).

Piacente differs in that the indicators are not color coded. Examiner takes Official Notice that it was well known in the art at the time of invention to color code hyperlinks on computer

graphical displays to make it easier for a user to visually distinguish the hyperlinks from non-linked text.

Accordingly, it would have been obvious to one of ordinary skill in the art to modify the indicators of Piacente (which are in fact hyperlinks, see "Note" on page 333) to be color coded to visually distinguish them from non-linked text, as is well known in the art.

42. Claim 159: Clicking the links on page 332 leads to new interfaces, such as that of page 334 which contain a list of cases that reference the first case.
43. Claim 160: See remarks for claim 134.
44. Claim 161: Forming the indicators in any known color would have been obvious to one of ordinary skill in the art as a choice of design.
45. Claim 162: See remarks for claims 158 and 159.
46. Claims 163-164: Forming the indicators in any known color would have been obvious to one of ordinary skill in the art as a choice of design.
47. Claim 165: See display of legal opinions on page 334.
48. Claim 166: See remarks for claim 134.

49. Claims 173-174: See remarks for claim 161.
50. Claim 176: The indicators include the ">" character which resembles a flag.
51. Claim 179: On page 332, the upper portion of the interface above the dashed line is a region which displays a first citation (*Wagner v. Kepler*). Indicators are provided below the dashed line (<=1>, <=2>, <=3>, etc.) to respond to user selection (see the "Note" on page 333) to display related cases. The indicators inherently exist in a certain color.

Piacente differs in that the indicators are not color coded. Examiner takes Official Notice that it was well known in the art at the time of invention to color code hyperlinks on computer graphical displays to make it easier for a user to visually distinguish the hyperlinks from non-linked text.

Accordingly, it would have been obvious to one of ordinary skill in the art to modify the indicators of Piacente (which are in fact hyperlinks, see "Note" on page 333) to be color coded to visually distinguish them from non-linked text, as is well known in the art. Forming the indicators in any known color would have been obvious to one of ordinary skill in the art as a choice of design.

52. Claim 135 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

53. **Applicant's arguments filed with respect to claims 126, 137, 143, 147, 158, 162, 167, 158-166, 173-174, and 176 have been fully considered but they are not persuasive.**

54. On page 32 of Applicant's Remarks to claim 126, applicant argues that:

*"Piacente merely shows a tool bar with a Shep button that by its appearance alone indicates nothing regarding the document being displayed. Indeed, all that the Shep button indicates is that a Shep function can be invoked by selection of the button. Thus, in Piacente user selection of the Shep button is a prerequisite to obtaining any information about a given legal document."*

The examiner respectfully disagrees with Applicant's argument because the features upon which applicant relies are not recited in the rejected claim. Furthermore, a "user-selectable means for indicating before user selection" is indefinite as explained above. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Piacente teaches the claimed material, as claim 126 recites:

*"the first control interface having first user-selectable means for indicating before selection whether the first legal document includes at least one portion having compromised legal authority and for invoking after selection display of a second interface screen".*

Reference is made to pages 330-339 of Piacente. A first control interface (two rows of radio buttons at the top of the screen) exists adjacent the data window. A first control interface (two

rows of radio buttons at the top of the screen) exists adjacent the data window. A first user selectable means, for indicating without user selection, (the "Shep" radio button and Shepard's pop-up box at page 331) will activate indications of legal authority on a second interface screen after selection as shown on page 334.

55. Claims 137, 143, 147, 158, 162, and 167 recite similar features to those found in claim 126 and the arguments of claim 126 are not persuasive as explained above; therefore they are anticipated by Piacente as well.

56. Arguments with respect to claims 158-166, 173-174, and 176 being rejected under 35 U.S.C. 103(a) as being unpatentable over Piacente in view of Official Notice are not persuasive. Applicant's amendments do not distinguish the claimed subject matter as shown above.

### ***Conclusion***

57. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Lawrence et al. (Pat. No. US 6,289,342).
- b. McKenzie ("Comparing KeyCite with Shepard's Online", Legal Reference Services Quarterly, Col. 17(3), 1999, pgs. 85-99).

58. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Additional Note: The Examiner of record has been changed from Sam Rimell to Jeremy Engelskirchen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEREMY D. ENGELSKIRCHEN whose telephone number is (571) 270-1903. The examiner can normally be reached on Mon.-Thurs. 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trujillo can be reached on (571) 272-3677. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JDE 6/4/2008

/James K. Trujillo/  
Supervisory Patent Examiner, Art Unit  
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